

REMARKS

Status of the Application

Claims 1-18 are all the claims pending in the application. Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaku (US Patent 7,154,550) in view of Nagai (US Publication 2001/0010561).

Claim Rejections - 35 U.S.C. § 103

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaku (US Patent 7,154,550) in view of Nagai (US Publication 2001/0010561).

The Examiner provides the same basic rejection in the instant Office Action as was provided in the Office Action dated November 8, 2007. Therefore, the following comments will be mainly directed toward the Examiner's Response to Arguments found on pages 2-3 of the instant Office Action.

In response to Applicant's argument that the Examiner's proposed combination of Kato and Nagai fails to render claim 1 obvious, the Examiner argues that:

Although Nagai teaches that the electronic zoom is performed when the camera is switched to the reproduction mode (playback mode as shown in Fig. 5), the teaching of Kaku clearly discloses that the camera is set to a playback mode for displaying the captured image as shown in Fig. 5 of Kaku (steps S23, S25-S29) when the shutter button is fully pressed for a predetermined time. *Thus, the combined teaching of Kaku and Nagai would render the claimed invention obvious because Kaku has set the camera into the playback mode by pressing*

down the shutter button for a predetermined time and then the user is allowed to view the captured image and to instruct the camera to perform zooming on the image during the playback mode as taught by Nagai. The Examiner understands that either Nagai or Kaku alone does not teach the Applicant's claimed invention, but the combination of Nagai and Kaku does teach the claim subject matter as discussed above and in the previous office action.

See pages 2-3 of the instant Office Action (emphasis added).

Applicants disagree with the Examiner's continued rejection over the proposed combination of Kaku and Nagai. Specifically, claim 1 recites "a control section which controls preview image display." Applicants submit that neither Kaku nor Nagai discloses a "preview image display" as recited in claim 1. The Examiner alleges that both Kaku and Nagai are directed toward "playback mode" displaying of captured images. Assuming, *arguendo*, that the Examiner is correct, then the Examiner concedes that both Kaku and Nagai have recorded the captured image prior to the display of the image as disclosed by Kaku and the zooming on the image disclosed by Nagai. Thus, the images shown on the display in Kaku and Nagai are not preview images, but are reviewable stored images (see at least, operation S21 "completing the recording process", which occurs before operation S23, which begins the "playback mode"). The preview image display recited in claim 1 occurs during an image capture process (i.e., when the , not during a "playback mode". Thus, the Examiner's proposed combination fails to disclose all of the elements of claim 1, and claim 1 is patentable over the applied art.

Claims 7 and 12 recite limitations similar to claim 1, and are patentable for reasons analogous to claim 1. Claims 2-6, 8-11 and 13-18 are patentable at least by virtue of their respective dependencies.

In addition, Applicants emphasize that the claim recites a dual characteristic relative to the ON state. In particular, a) the ON state is continuously detected and b) another instruction is detected during the ON state (full depression), then the display size can be changed. The combination of Kaku and Nagai does not offer this duality. There can be no zooming in Kaku with the depression of the shutter release (purported ON state). Similarly, there is also no zooming in Nagai with the continual depression of the shutter. Contrary to the Examiner's contention continual depression of a shutter release in Kaku and Nagai does not switch a mode in Nagai that permits the zoom. A completely different operation is required instead, by the combined teachings. The Examiner cannot simply ignore the teachings of Nagai, except through application of improper hindsight. A complete redesign in operation is not obvious. Nagai includes multiple playback modes including simple playback and auto zoom, each having no additional instructional input, and a manual zoom. Simply putting Nagai in playback mode is not sufficient to distinguish the various modes of Nagai. However, the Examiner's proposed modification effectively negates at least two disclosed playback modes of Nagai, thereby undermining the operation of Nagai. Such modifications are not supportable. Similarly, the Examiner's rationale that maintaining the shutter in the ON state (Kaku) and simultaneously zooming adjustments (Nagai) is not an "easier" operation as the Examiner contends. This is because Nagai allows the zooming by operation of a separate viewing mode without the user

having to continually maintain the shutter release. All of the Examiner's rationales are not supportable.

Claim 17 describes the instruction of the ON state relative to the shutter release. It is clear in Nagai (paragraph [0021]) that the shutter release must be off to perform zoom.

New Claims

Applicants hereby add new claims 19 and 20. Claims 19 and 20 depend from claim 1, and are patentable at least by virtue of their dependency.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Dion R. Ferguson/

Dion R. Ferguson
Registration No. 59,561

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 5, 2008